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OFFICE OF PETITIONS

ON PETITION

In re Application of
Imoto
Application No. 10/689,305
Filed: October 20, 2003
Attorney Docket No. 09792909-5755
For: METHOD OF FABRICATING
SEMICONDUCTOR DEVICE HAVING
SEMICONDUCTOR RESISTANCE ELEMENT

This is a decision on the petition filed March 11, 2004, requesting that Figures 5 and 6 be entered into the above-identified application and that the application retain an October 20, 2003 filing date.

The application was filed on October 20, 2003. However, on January 21, 2004, The Office of Initial Patent Examination mailed a "Notice of Omitted Items in a Nonprovisional Application" (Notice) stating that the application had been accorded a filing date of October 20, 2003, and advising applicant that figures 5 and 6, as described in the specification, appeared to have been omitted.

In response, the present petition was filed. Petitioner argues that figures 5 and 6 should be included with the papers filed on October 20, 2003, because they were originally filed in prior application No. 09/862,042, the entire disclosure of which was incorporated by reference at the time of filing.

The petition is **DISMISSED**.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing items were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioner neither asserts that the missing figures were actually deposited in the PTO on October 20, 2003, with the other application papers, nor requests a later filing date.

Instead, applicant seeks to add the figures to the present application on the basis that the figures are not new matter. However, no petition is necessary for that purpose. Additional figures may be entered by the primary examiner **without a petition** so long as the figures contain no new matter. See MPEP § 608.02(a).

MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

If applicant desires that figures 5 and 6 be added to the application, the appropriate procedure is by way of amendment requesting the entry of the figures. Any such amendment should be filed prior to the first action on the merits and will be considered by the primary examiner.

Accordingly, the petition is inappropriate and is subject to dismissal. The petition fee will not be refunded, since the petition was not necessitated by any error on the part of the Office.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of October 20, 2003. Figures 5 and 6, submitted with the instant petition, will **not** be processed at this time.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6712.



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